

RECEIVED

SEP 28 2004

TECH CENTER 2800

Patents



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:

Tan Huynh et al.

Reissue of U.S. Patent No. 5,917,455

Serial No.: 10/747,818

Filed: December 29, 2003

For: Electrically Variable Beam Tilt Antenna

)
)
)
) Group Art Unit: 2821
)
) Examiner: To BE Assigned
)
)


PROTEST OF REISSUE APPLICATION UNDER 37 C.F.R. § 1.291

Certificate of Service

The undersigned hereby certifies that a Protest of Reissue Application Under 37 C.F.R. § 1.291 including FIGS. 1-4 has been served in accordance with C.F.R. § 1.248 by United States First Class Mail addressed to the following on **September 22, 2004**:

Eric D. Cohen
Welsh & Katz, Ltd.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606

Certified By:


By: Michael J. Mehrman
Reg. No. 40,086

Mehrman Law Office, P.C.
5605 Glenridge Drive, Suite 795
Atlanta, GA 30342
404 497 7400 telephone
404 497 7405 facsimile
mike@mehrmanlaw.com



RECEIVED

SEP 28 2004

9-23-04

sfw

Patents

**TECH CENTER 2800
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue Application of:

Tan Huynh et al.

Reissue of U.S. Patent No. 5,917,455

Serial No.: 10/747,818

Filed: December 29, 2003

For: Electrically Variable Beam Tilt Antenna

)
)
)
) Group Art Unit: 2821
)
) Examiner: To Be Assigned
)
)
)

PROTEST OF REISSUE APPLICATION UNDER 37 C.F.R. § 1.291

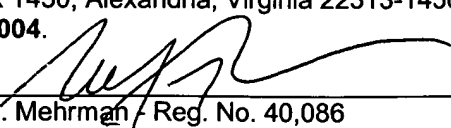
Mail Stop Reissue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 22, 2004

Sir:

This Protest is filed pursuant to 37 C.F.R. § 1.291 against United States Patent Application Serial No. 10/747,818, Reissue of United States Patent No. 5,917,455, because this Reissue Application seeks to broaden the subject patent in violation of 35 U.S.C. § 251. The subject patent issued on June 29, 1999 and, for this reason, the two-year period for filing a broadening reissue application under 35 U.S.C. § 251 has long expired. In an effort to avoid this statutory bar, the Reissue Applications claims to be non-broadening. As explained below, however, the claims sought in the Reissue Application would clearly broaden the subject patent under the controlling law, and therefore must be rejected.

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office By United States Express Mail No. **ER853603676US** addressed to Mail Stop Reissue, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on **September 22, 2004.**


Michael J. Mehrman - Reg. No. 40,086

LISTING OF INFORMATION RELIED UPON

This Protest relies on FIGS. 1-4, which are filed concurrently herewith.

CONCISE STATEMENT OF THE RELEVANCE OF EACH REFERENCE

35 U.S.C. § 251 states that “No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.” Under settled law, a claim in a reissue application enlarges the scope of the original patent within the meaning of 35 U.S.C. § 251 “if any amended claim in the reissue contains within its scope any conceivable product or process which would not have infringed the [original] patent. MPEP § 1412.03 (citing Tillotson Ltd v. Walbro Corp., 831 F.2d 1033, 1037 n.4 (Fed. Cir. 1987) (additional citations omitted). The MPEP further explains that, “A claim which reads on something which the original claims do not is a broadening claim.

In the subject Reissue Application, similar amendments are sought for independent claims 1, 24 and 32. These amendments would change the claim language as follows:

-- phase adjustment means [mechanism] disposed between the first [second] and third antenna groups --

These claims, if amended as requested, would clearly read on subject matter that the original claim does not. For example, a device that includes a phase adjustment mechanism disposed between the first and second antenna groups falls outside the scope of the original claims, yet would fall within the scope of the amended claim. This configuration is shown in FIG. 1 submitted herewith. Similarly, a device that includes a phase adjustment mechanism disposed between antenna elements of the second antenna group falls outside the scope of the original claims, yet would fall within the scope of the amended claim. This configuration is shown in FIG. 2 submitted herewith. Further, a device that includes a phase adjustment mechanism disposed adjacent to the second antenna group falls outside the scope of the original claims, yet would arguably fall within the scope of the amended claim. This configuration is shown in FIG. 3 submitted herewith. This is true whether the second antenna group includes multiple antenna elements, as shown in FIG. 3, or if the second antenna group includes

a single antenna element, as shown in FIG. 4. Accordingly, these requested amendments would clearly enlarge the scope of the original patent in violation of 35 U.S.C. § 251.

In addition, the Reissue Application seeks a further amendment of claim 1 that would change the language of this claim as follows:

-- configured to simultaneously advance a phase angle of a signal to one of said first [second] and third antenna groups and delay the phase angle of said signal to the other of said first [second] and third antenna groups --

This amendment requested by the Reissue Application would also be a broadening amendment because the original claim does not read on a configuration that delays the signal to the first antenna group, whereas the amended claim would read on such a configuration. Accordingly, this amendment is a broadening amendment within the meaning of 35 U.S.C. § 251, as explained in MPEP § 1412.03 (citing Tillotson Ltd v. Walbro Corp., 831 F.2d 1033, 1037 n.4 (Fed. Cir. 1987).

CONCLUSION

For the reasons explained above, the amendments requested in the subject Reissue Application must be rejected because they would broaden the subject patent in violation of 35 U.S.C. § 251.

Respectfully submitted,


By: Michael J. Mehrman
Reg. No. 40,086

Mehrman Law Office, P.C.
5605 Glenridge Drive, Suite 795
Atlanta, GA 30342
404 497 7400 telephone
404 497 7405 facsimile
mike@mehrmanlaw.com